REMARKS/ARGUMENTS

Initially, Applicant would like to drawn the Examiner's attention to the fact that two

Supplemental Information Disclosure Statements were recently filed in the present patent

application on October 7, 2010 and on September 3, 2010, and have not yet been considered by

the Examiner. Thus, Applicant respectfully requests that these two Supplemental Information

Disclosure Statements be considered by the Examiner, and that an indication thereof be provided

in the next Official communication.

In the Official Action, claims 11-17, 21-22, and 24-25 were rejected under 35 U.S.C. §

101 as being directed to non-statutory subject matter. Claims 11-12, 15-19, 21, and 24-25 were

rejected under 35 U.S.C. § 103(a) as being unpatentable over MENSCHIK et al. (U.S. Patent

Application Publication No. 2005/0027995 A1) in view of GOKHALE et al. (Non-Patent

Literature: "GriT: A CORBA-based GRID Middleware Architecture") and EDELSON et al.

(U.S. Patent No. 5,737,539). Claims 13-14 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over MENSCHIK in view of GOKHALE, EDELSON, and CROWCROFT (Non-

Patent Literature: ACM Article). Claim 22 was rejected under 35 U.S.C. § 103(a) as being

unpatentable over MENSCHIK in view of GOKHALE, EDELSON and RODRIGUEZ (Non-

Patent Literature: IEEE Article).

Upon entry of the present amendment, claims 11, 13, 15-19, 21-22, and 24 have been

amended. Claims 1-10, 20, and 23 were previously cancelled. New dependent claim 26 has

been added. Thus, claims 11-19, 21-22, and 24-26 are currently pending for consideration by the

Examiner.

In the Official Action, claims 11-17, 21-22, and 24-25 were rejected under 35 U.S.C. §

101 as being directed to non-statutory subject matter. More specifically with regard to

independent claim 11, the Examiner asserts that since the "receiver" is not positively recited as being a structural feature of the claim, that the claim can be construed as being directed to software *per se*.

In the present amendment, Applicant has amended independent claim 11 to explicitly recite that the relay server includes a receiver, a controller, a memory, and a transmitter. Thus, Applicant respectfully submits that amended independent server claim 11, and related dependent claims 12-17, 21-22, and 24-25, fall squarely into the "machine" statutory category of invention under 35 U.S.C. § 101. Applicant further submits that each of these claims recite a specific machine, and are not directed to an abstract idea or to software *per se*. Accordingly, Applicant respectfully requests that the rejection of apparatus claims 11-17, 21-22, and 24-25 under 35 U.S.C. § 101 be withdrawn.

In the Official Action, claims 11-12, 15-19, 21, and 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MENSCHIK in view of GOKHALE and EDELSON. Applicant respectfully submits that the specific combination of features explicitly recited in each of amended independent claims 11, 18, and 19 would not have been obvious to one of ordinary skill in the art at the time of the invention for several reasons.

Applicant submits that each of amended independent claims 11, 18, and 19 generally recites the following five distinctive features, which are identified below as features (1) through (5):

(1) a relay server establishes an SIP session, between a client terminal and an application server, via the relay server;

(2) the client terminal and the application server directly establish <u>an application session,</u> and the client terminal directly receives a service other than Internet telephony from the application server;

(3) the service is <u>a different service from Internet telephony;</u>

(4) the relay server, upon establishing the SIP session between the client terminal and the application server via the relay server, performs <u>predetermined operations (including receiving an SIP session establishment request, authenticating the client terminal, searching the application server, relaying the SIP session establishment request, relaying an SIP response from the application server, relaying an SIP confirmation request from the client terminal);</u> and

(5) the SIP response from the application server is provided to establish an application session and includes <u>information related to a method of accessing</u> the service provided by the application server.

Applicant respectfully submits that neither MENSCHIK, nor GOKHALE, nor EDELSON, nor the combination thereof, discloses or renders obvious the specific above-noted features (1) through (5), relating to amended independent claims 1, 18, and 19.

Applicant submits that the amended independent claims recite that in an application different from Internet telephone, when a user receives a service that is different from Internet telephone from an application server, a relay server performs user authentication upon establishing an SIP session, so that the application server does not have to have an authentication function, and can thus be built in a less complex configuration. Additionally, the relay server is able to improve the efficiency of use of its user authentication function, and reduce its operational costs by, for example, billing the application server. Furthermore, the user is able to efficiently establish an application session by using information related to an access method.

See, for example, the sections of Applicant's specification that correspond to paragraphs [0110] and [0111] in U.S. Patent Application Publication 2006/0095501 A1 of the present patent application.

With regard to independent claim 11, the Official Action asserts that MENSCHIK discloses the claimed "requester," "authenticator," "searcher," "service inquiry relayer," "response relayer," and "confirmation relayer". See Official Action, pages 5-6, items (a)-(f). The Official action acknowledges that MENSCHIK fails to disclose contacting the source computer directly to inquire if the source computer can provide the requested data. However, the Official Action asserts that EDELSON teaches that if a patient is not found in the indexed directory located at the central host computer, searching all remote computers directly to determine if any of these remote computers contain the requested data, citing EDELSON's column 8 line 50-54. The Official Action concludes that independent claim 11 would have been obvious.

In the present amendment, Applicant has amended independent claim 11 to identify the corresponding SIP messages in detail, and to explicitly recite the functional feature associated with each data item. Thus, Applicant respectfully submits that the combination of MENSCHIK, GOKHALE, and EDELSON fails to disclose at least the "requester," "authenticator," "searcher," "service inquiry relayer," "response relayer," and "confirmation relayer" features recited in amended independent claim 11.

For example, amended independent claim 11 sends an inquiry (that is, relay an SIP session establishment request) only to a "searched" application server. In distinct contrast, EDELSON searches "all" remote computers when there is a patient not listed in a directory service. EDELSON does not limit the target of search, and, in this aspect, significantly differs

from the features recited in amended independent claim 11. Furthermore, Applicant submits that MENSCHIK does not disclose the feature of amended independent claim 11 relating to the receiving a response from an application server when an SIP session is established.

The Official Action also acknowledges that MENSCHIK fails to disclose the establishing of an SIP session. However, the Official Action asserts that GOKHALE discloses this feature. More specifically the Official Action asserts that GOKHALE teaches using an SIP session to share medical data. (See Official Action, page 4.)

Applicant respectfully submits that although GOKHALE may disclose an SIP session, according to the disclosure of GOKHALE's Figure 2 and chapter 2, an SIP session is established only between a terminal and a GSP (relay server), and beyond GSP, CORBA is used. Consequently, Applicant submits that the configuration of GOKHALE is entirely different from Applicant's configuration as recited in amended independent claim 11, which is designed to allow a relay server to establish an SIP session between a client terminal and an application server via the relay server. Consequently, GOKHALE does not disclose the feature of amended independent claim 11 of exchanging signals as "relay server" functions upon establishing an SIP session, that is, exchanging "service request information," "SIP session establishment request," "SIP response" and "SIP confirmation request."

Applicant submits that one of the distinctive features of amended independent claim 11 lies in this exchange of signals upon SIP session establishment (See feature (4) recited above). Although an SIP session itself may be generally known, Applicant submits the recited specific manner in how Applicant uses the signals therein was not known. Applicant further submits that GOKHALE fails to disclose these specific features recited in amended independent claim 11.

As a further matter, in the Official Action, page 6, lines 10-14, the Examiner states: "Regarding the SIP session being active while the data is streamed, this feature is found in Gokhale (page 8 column 2 Section 2.3.5). Additionally, the SIP is an extremely well known layer of the Internet Protocol, as is evident by GOKHALE. Therefore, the combined teachings of the applied art suggest this limitation."

Applicant respectfully traverses this assertion. More specifically, Applicant submits that the part of GOKHALE cited by the Examiner does not explicitly disclose an SIP session and another application session (the session to actually provide services) coexisting. In contrast, amended independent claim 11 discloses establishing an SIP session to an application server, not only between a client terminal and a relay server (See feature (1) above.); the relay server receives a special response (i.e. SIP response) including special information for accessing the application server (i.e. information including information related to access method) (See feature (5) above.); and the client terminal directly accesses the application server using that information (See feature (2) above.). Thus, GOKHALE discloses establishing an SIP session only between a terminal and a GSP (relay server), as mentioned above, but does not explicitly disclose the specific features of amended independent claim 11, as referenced above.

Furthermore, in the Official Action, page 12, line 10, to page 13, line 16, in "Response to Arguments," the Official Action states: "The SIP protocol is extremely well known. According to Gokhale, an SIP session is established directly between two computers, i.e. in an *ad hoc* manner. No pre-negotiated security is required from the central server. Therefore, the asserted advantages do not distinguish the claimed invention from the applied art."

Applicant also respectfully traverses this assertion. In this regard, Applicant submits that the Official Action has misinterpreted GOKHALE. In other words, according to GOKHALE,

the word "ad hoc" is used to mean whether resources are used continuously or resources are used when necessary (that is, on an ad hoc basis), as described in GOKHALE's section 2.3.1 (pages 6-7). In distinct contrast, the advantage of the amended independent claim 11 is to reduce the load in an application server by performing authentication in a relay server, so that authentication itself is kept and executed.

In the Official Action, page 13, lines 10-16, in "Response to Arguments," the Official Action states "The claim recites 'comprising.' Therefore, the scope of the claim can envelop additional unrecited steps. As long as the applied art discloses searching in the manner as recited at one computer (as discussed above), the fact that the applied art repeats the steps at additional computers is not germane to the rejection. If Applicant intends for searching to be done at only a single computer, Applicant should amend the scope of the claim accordingly."

Applicant submits that amended independent claim 11 makes an inquiry (that is, relay a session establishment request) only to a "searched" application server. In contrast, EDELSON searches "all" remote computers when there was a patient not listed in a directory service. Therefore, Applicant submits that EDELSON does not limit the target of search, which is distinctly different from amended independent claim 11.

Furthermore, to further emphasize the distinctions of amended independent claim 11 over the applied prior art, Applicant has limited "service" to be provided by "application server" in each of amended independent claims 11, 18 and 19, to be "service that is different from Internet telephone" (See feature (3) above.). In a telephone communication system using SIP, Applicant submits that a configuration to allow a media session to be executed on a peer-to-peer basis after an SIP session is established, for connection between a terminal and a non-internet application sever, was not known in the prior art. For example, for an application different from the Internet

such as Web browsing, a relay server (HTTP Proxy) always relays a session between a terminal and an application server (Web server). Consequently, it would not have been obvious to one of ordinary skill in the art at the time of the invention to configure a system that targets an application server that provides services different from Internet telephone, and is configured such that a relay server establishes an SIP session between a client terminal and an application server via the relay server, and the application server provides the service different from Internet telephone directly to the client terminal, in another application session between the client terminal and the application server.

As a final matter, in response to the Examiner's indication on pages 7 to 8 of the Official Action, the features of "service request information," "SIP session establishment request," "SIP response" and "SIP confirmation request" recited in independent claims 1, 18 and 19; "disconnection request" recited in claim 13; "service change information" and "session change information" recited in claim 15; "session transfer request" recited in claim 16; and "cancel request" recited in claim 22, are amended in the claims to provide details as to which SIP massages that these elements refer. Support for these amendments are at least provided in the sections of Applicant's specification that correspond to paragraphs [0027], [0033], [0037], [0041], [0048], [0075], [0089] and [0091] in the U.S. Patent Application Publication 2006/0095501 A1 of the present patent application.

Furthermore, in order to emphasize the distinction of the features of amended independent claims 11, 18, and 19 over the applied prior art, the term "service" provided by "application server" in amended independent claims 11, 18 and 19 has been amended to refer to "service other than Internet telephony." Support for this amendment is at least provided in the

section of Applicant's specification that correspond to paragraph [0110] in U.S. Patent Application Publication 2006/0095501 A1 of the present patent application.

For at least the reasons discussed above, Applicant respectfully submits that the specific combination of features explicitly recited in amended independent claim 11 would not have been obvious to one of ordinary skill in the art at the time of the invention. Additionally, Applicant submits that amended independent claims 18 and 19 are also patentable for reasons similar to the reasons discussed above regarding amended independent claim 11, since amended independent claims 18 and 19 recite features similar to the features recited in amended independent claim 11. Furthermore, Applicant submits that dependent claims 12, 15-19, 21, and 24-25, which depend on amended independent claim 11, are also patentable for at the reasons discussed above regarding amended independent claim 11, and further for the additional features recited therein. Accordingly, Applicant respectfully requests that the rejection of claims 11-12, 15-19, 21, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over MENSCHIK in view of GOKHALE and EDELSON be withdrawn.

Claims 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MENSCHIK in view of GOKHALE, EDELSON, and CROWCROFT (Non-Patent Literature: ACM Article). Applicant respectfully submits that the specific combination of features explicitly recited in dependent claims 13-14, which depend upon amended independent claim 11, would not have been obvious to one of ordinary skill in the art at the time of the invention for at least the reason that CROWCROFT fails to remedy the distinct deficiencies of MENSCHIK, GOKHALE, and EDELSON discussed above regarding amended independent claim 11. Additionally, Applicant submits that dependent claims 13-14 are further patentable for the additional features recited therein. Accordingly, Applicant respectfully requests that the

rejection of claims 13-14 under 35 U.S.C. § 103(a) as being unpatentable over MENSCHIK,

GOKHALE, EDELSON, and CROWCROFT be withdrawn.

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over MENSCHIK

in view of GOKHALE, EDELSON and RODRIGUEZ (Non-Patent Literature: IEEE Article).

Applicant respectfully submits that the specific combination of features explicitly recited in

dependent claim 22, which depends upon amended independent claim 11, would not have been

obvious to one of ordinary skill in the art at the time of the invention for at least the reason that

RODRIGUEZ fails to remedy the distinct deficiencies of MENSCHIK, GOKHALE, and

EDELSON discussed above regarding amended independent claim 11. Additionally, Applicant

submits that dependent claim 22 is further patentable for the additional features recited therein.

Accordingly, Applicant respectfully requests that the rejection of claim 22 under 35 U.S.C. §

103(a) as being unpatentable over MENSCHIK, GOKHALE, EDELSON, and RODRIGUEZ be

withdrawn.

As a final matter, Applicants respectfully submit that the Official Action has

impermissibly resorted to impermissible hindsight reasoning using Applicant's disclosure as a

guide, in formulating the rejections. More specifically, with regard to the rejections of claims

11-19, 21-22, and 24-25, the Official Action has impermissibly pieced together three and four

distinct references by selectively picking various pieces of each reference and combining these

pieces in a highly selective manner.

Applicant submits that the particular combinations of reference sections asserted in the

Official Action would not have been obvious to one of ordinary skill in the art at the time of the

invention, given the limitless number of possible combinations that could have been formed by

these many references. Instead, Applicant submits that the Official Action formulated the

particular combinations by following Applicant's own disclosure as a roadmap, instead of relying on the knowledge of one of ordinary skill in the art at the time of the invention. Accordingly, Applicant respectfully submits that the asserted rejections are improper and should be withdrawn.

Finally, Applicant submits that new dependent claim 26, which depends upon amended independent claim 11, is patentable for at least the reasons discussed above regarding amended independent claim 11, and further for the additional features recited therein.

In conclusion, Applicant respectfully requests that the various claim rejections under 35 U.S.C. § 103(a) be withdrawn, and that an indication of the allowability of currently pending claims 11-19, 21-22, and 24-26 be provided in the next Official communication.

SUMMARY

From the amendments, arguments, and remarks provided above, Applicant submits that all of the pending claims in the present patent application are patentable over the references cited by the Examiner, either alone or in combination. Accordingly, reconsideration of the outstanding Official Action is respectfully requested and an indication of the allowance of claims 11-19, 21-22, and 24-26 is now believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the present patent application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejections is made by the present amendment. All other amendments to the claims which have been made by this amendment and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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